

REMARKS

Applicants respectfully request reconsideration of the present application in view of the reasons that follow.

I. Status of Claims and Amendments

Claim 6 is canceled without prejudice or disclaimer.

Claim 1 is amended to incorporate the subject matter of canceled claim 6. No new matter is being added.

Upon entry of the amendments, claims 1, 7-11, 13-17, and 19-21 will be pending, while claims 8-11 and 13-17 are withdrawn from consideration. Claims 1, 7, and 19-21 are subject to examination on the merits.

II. Foreign Priority Claim

The Examiner notes that the pending claims are not entitled to the claimed foreign priority date because “the instant claims and parent document differ in the region that is deleted.” Office Action at pg. 3.

While not acquiescing in this conclusion, Applicants address below the purported prior art on the merits. Specifically, even if Bett is prior art, it does not render obvious the claimed invention when combined with Vogels.

III. Claim Rejections under 35 USC § 103

A. *Vogels et al.*, U.S. patent No. 6,492,169, in view of Bett, U.S. Publication No. 2004/0106194

Claims 1, 6, 7, and 19 stand rejected under 35 U.S.C. § 103 as allegedly obvious over *Vogels et al.*, U.S. patent No. 6,492,169, in view of Bett, U.S. Publication No. 2004/0106194. The Examiner notes that Vogels does not teach any E3 region deletion, and Bett is cited to remedy this deficiency. Applicants respectfully traverse this ground of rejection.

Vogels does not teach an Ad35 vector comprising *any* deletion in the E3 region, as recognized by the Examiner. See Office Action at pg. 5. Bett merely mentions that a passenger gene can be inserted in “an E3-deleted region” (¶ [0065]) and that an Ad35 vector

comprising a deletion in the E3 region ([0092] and [0096]) can be constructed.¹ Yet Bett does not clearly disclose a specific E3 region for the deletion, including the claimed deletion “between nucleotides 27,760 and 29,732 of the adenovirus type 35 genome.”

If the whole range of the E3 region is deleted, Ad viruses cannot stably exist. This is so because the E3 region contains a polyA signal involved in a stable expression of pVIII gene, which constitutes the viral capsid. Along these lines, Exhibit A attached hereto shows information on the pVIII gene including the polyA signal (underlined). The underlined polyA signal corresponds to the nucleotide sequence between 27,505 and 27,510 of SEQ ID NO. 1 of the present application.

Because the claims require deletion in the E3 region between nucleotides 27,760 and 29,732 of the adenovirus type35 genome, the claimed Ad 35 vector retains the polyA signal pVIII gene. Bett does not teach such instability of Ad viruses by deletion of E3 region, and in no way suggests the very specific deletion recited by the claims. Therefore, one of ordinary skill in the art would not have been motivated to limit the specific range for deletion of E3 region recited in claim 1. There is simply no motivation or reason to do so.

While *KSR* rejected the Federal Circuit’s strict teaching/suggestion/motivation test, a *prima facie* case of obviousness still requires some reason in the prior art to modify the prior art. *KSR* is not a license to engage in construction of the claimed invention based purely on hindsight or the teachings of the applicants’ specification. Here, there is simply no reason in the prior art to make the specific deletions recited in the claims.

B. Vogels in view of Bett further in view of Wadell *et al.*, U.S. Publication No. 2004/0136958

Claims 1, 7, and 19-21 stand rejected under 35 U.S.C. § 103 as allegedly obvious over Vogels in view of Bett further in view of Wadell *et al.*, U.S. Publication No. 2004/0136958.

While not acquiescing to the propriety of the rejection, Applicants amended claim 1 to recite the subject matter of claim 6, which was not subject to this rejection. Thus, the amendments renders moot this ground of rejection.


¹ By addressing Bett, Applicants do not concede that Bett is competent prior art to the claimed invention.

CONCLUSION

Applicants submit that the present application is in condition for allowance, and an early indication to that effect is requested. Examiner Marvich is invited to contact the undersigned directly should she feel that any item warrants further consideration.

Respectfully submitted,

Date April 28, 2010

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The Commissioner is hereby authorized to charge any additional fees, which may be required under 37 CFR §§ 1.16-1.17, and to credit any overpayment to Deposit Account No. 19-0741. Should no proper payment accompany this response, then the Commissioner is authorized to charge the unpaid amount to the same deposit account. If any extension is needed for timely acceptance of submitted papers, then Applicant hereby petitions for such extension under 37 CFR § 1.136 and authorizes payment of the relevant fee(s) from the deposit account.